

REMARKS

In a telephone interview conducted with examiner Chencinski and another examiner on May 17, 2006, the applicant's representatives David Feigenbaum and Misha Hill discussed proposed claim amendments. The examiners suggested that the claims may be rejected under § 101 for failure to claim patentable subject matter. In particular, the examiners contrasted the present claims with those in *In re Alappat*, 33 F.3d 1526.

The applicant has amended claims 14 and 28 to apply a mathematical algorithm in a practical manner to produce, as a whole, a useful, tangible result, as guided by *AT&T v. Excel*, 172 F.3d 1352 (Fed. Cir 1999), in which the court approved of claims similar to those in this application as now amended. In *AT&T v. Excel*, the claims applied a Boolean principle without pre-empting other uses of the mathematical principle.

To the extent that the previous rejection under § 103(a) may still be relevant, the applicant responds below. The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type). Claims 1-13, 19-21, and 24-27 have been cancelled. Claims 14, 18, 22, 23, and 28 have been amended.

2. Claims 14-16, 18, 19, 22 and 23 are rejected under 35 U.S.C. 103(a) as being disclosed by Makivic (US Patent 6,061,662) in view of Official Notice.

Re. Claim 14, Makivic discloses a method on a computer of displaying of probability information concerning the future value of a financial security. Makivic does not explicitly disclose a method comprising displaying to a user a visualization element that indicates the odds of a performance measure of an asset being within displayed ranges of identified values of the performance measure at a succession of times in the future.

However, a probability of a future event is the same as the odds of a future event. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention that a probability has to relate to the odds of some specific measure or range which is less than the possibility of all future outcomes, which are 1 or 100%. Therefore, an ordinary practitioner of the art would have found it obvious to use the disclosure of Makivic to display probability information of a certain range of future performance outcomes of a financial asset, motivated by an increased demand for on-line services in the area of investment decision support resources (Makivic, Col. 2, II. 50-53).

7. Applicant's arguments filed December 19, 2006 have been fully considered but they are not persuasive.

ARGUMENT:

B. Re. Claim 14, Applicant argues that (1) the mere display of probability information concerning future values of a security .. does not describe and would not have made obvious displaying elements that indicate the odds of such values "being within displayed ranges of identified values ... at a succession of times in the future" (p. 11, ll. 18-21). (2) the examiner has not identified any suggestion to combine the method of Makivic with anything else to achieve the claimed method, not has he identified any prior art reference actually containing the claimed elements (p. 11, ll. 23-25).

RESPONSE :

A. Re. Claim 1

(1) There is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) ... and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 9ccpa) 1969.

In this case, the examiner has relied on what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art.

(2) ... the burden of proof falls on the Applicant to demonstrate why the examiner's judgment about the suggestions drawn by one of ordinary skill from the combined references would be unreasonable ("[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on 'prima facie obviousness' under 35.U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). The examiner finds that Applicant has not made a persuasive argument, in fact has not really addressed the subject of what the ordinary practitioner would find obvious when considering all of the references as a whole in combination with the practitioner's own knowledge base.

B: Re. Claim 14:

(1) The examiner has not identified a suggestion to combine the cited references (per *In re Vaack* and *In re Fine*) (page 10, II. 15-21).

(2) "... the examiner has not identified any actual prior art describing or suggesting the combination of the various different graph elements combined in the claimed visual display" (p. 10,11.21-30).

RESPONSE :

(1) Makivic displays ranges for projected stock prices in graphic form in Fig. 5.

(2) As stated in the response to Applicant's argument regarding claim 1, the examiner has made the judgment that one of ordinary skill would find it obvious to see the suggestions for claim 14 in Makivic for the reasons given in the rejection, which his repeated above for Applicant's convenience. The burden of proof is on Applicant to make a persuasive case in rebuttal of that judgment.

The applicant disagrees. Amended claim 14 includes "displaying in [a] visualization system" the combination resulting from "generating a trend line showing values of a performance measure at a succession of times prior to a date," and "generating stripes that indicates the odds of the performance measure being within a corresponding range of potential

values of the performance measure at a succession of times in the future,” in which “the stripes begin at the end of the trend line and become broader as they extend to times later than the date” and with “the width and position of each stripe being determined by an algorithm,” as a function of time.

No combination of the references would have produced such a combination of different elements without the guidance of hindsight, specifically, the applicant's recognition that such a combination offered new insight into securities prices. The claim is intended to use any algorithm capable of determining predicted probability distributions to determine the boundary of each stripe as a function of time.

To arrive at the current claims would have required one skilled in the art to have taken multiple steps to combine the known methods in order to reach the claimed invention. While a motivation to take these multiple steps need not be explicitly stated in a reference, it is well established that a prima facie case of obviousness “cannot be established ... absent some teaching or suggestion supporting the combination.” *In re Fine*, 837 F.2d 1071, 1075, (Fed. Cir. 1988).

With regard to E*Trade, the page of etrade.com provided by the examiner in the office action of September 15, 2005, shows only a line graph of historical values. The applicant requests that if the examiner is aware of “line graphs which show actual historical values one end of which joins the visualization element at a point which represents a current date,” in use prior to the filing date of this application, he provide these to the applicant..

Re. Claim 18, Makivic does not explicitly disclose a method in which the visualization element include stripes superimposed on a graph of the performance measure over time, each of the stripes representing one of the displayed ranges. However, the superimposing of stripes on a graph is a well known way of distinguishing and highlighting data on a graphic display. Therefore, an ordinary practitioner of the art would have found it obvious to combine the disclosure of Makivic with the well known technique of superimposing of stripes on a graph in order to display performance measure over time, motivated by an increased demand for on-line services in the area of investment decision support resources (Makivic, Col. 2, II. 50-53).

Re. Claim 19, Makivic does not explicitly disclose a method in which each of the stripes begins at a current time and becomes broader as it extends to future times. However using stripes which become broader as a time series changes with a parameter is a well known display technique variation of using stripes. Therefore, an ordinary practitioner of the art would have found it obvious to combine the disclosure of Makivic with the well known technique of superimposing of stripes of increasing broadness on a graph in order to display

performance measure over time, motivated by an increased demand for on-line services in the area of investment decision support resources (Makivic, Col.2, II. 50-53).

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being disclosed by Makivic in view of Official Notice and Gatto.

Re. Claim 20, Makivic does not explicitly disclose a method of displaying a graphical device that shows actual historical values of the performance measure. Gatto discloses displaying a graphical device that shows actual historical values of the performance measure (Fig. 2). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Makivic with well known prior art and the art of Gatto in order to display a graphical device that shows actual historical values of the performance measure, motivated by the desire to provide users with improved tools for effectively viewing historical estimates, projections and recommendations regarding financial assets such as securities (Gatto, [0008]).

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being disclosed by Makivic in view of Official Notice, Gatto and Applicant admitted prior art (E Trade.com, Window printed line graph image dated 7/17/2000).

Re. Claim 21, Makivic does not explicitly disclose a method in which the graphical device that shows actual historical values is a line graph one end of which joins the visualization element at a point which represents a current date. However, E Trade.com carries line graphs which show actual historical values one end of which joins the visualization element at a point which represents a current date. It would have been obvious for an ordinary practitioner of the art at the time of Applicant's invention to have combined the teachings of Makivic with well known prior art, Gatto and those of Applicant's admitted prior art of E Trade for the purpose showing actual historical values in a line graph one end of which joins the visualization element at a point which represents a current date, motivated by an increased demand for on-line services in the area of investment decision support resources (Makivic, Col. 2, II. 50-53). 6. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being disclosed by Gatto in view of archive.com's Wayback Machine (yahoo.com - November 16, 1999 and msn.com - November 28, 1999, hereafter the Wayback Machine).

Claim 14 has been amended to incorporate elements of claims 19-21, now cancelled, thus the remarks above are responsive to the examiner's rejection of those claims. Claim 28 has been amended and is patentable for similar reasons as claim 14.

Re. Claim 15, ...

Re. Claim 16, ...

Re. Claim 22, ...

Re. Claim 23, ...

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being disclosed by Makivic in view of Official Notice and Jones.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Applicant : Lisette Cooper et al.
Serial No. : 09/836,484
Filed : April 17, 2001
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Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

No fees are believed due at this time. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 6/5/6



David L. Feigenbaum
Reg. No. 30,378

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906